



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,823	01/12/2001	Lowell R. Tully	29627/36393	2733

7590 04/28/2003

David C Read Esq
Marshall O'Toole Gerstein Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402

EXAMINER

SELLS, JAMES D

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,823

Applicant(s)

TULLY ET AL.

Examiner

James Sells

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

It appears that the consent of assignee and the 37 CFR 3.73(b) statement were signed by a person authorized to act on behalf of the previous assignee, Inertia Friction Welding, Inc., and not the current assignee, S.S.C. Control Technology. The consent of assignee and the 37 CFR 3.73(b) statement must be signed by a person authorized to act on behalf of the current assignee.

2. The amendment filed January 12, 2001 proposes changes to claims 9-25. However, applicants have not provided an explanation of the support in the disclosure of the patent for the changes made to the claims as required by 37 CFR 1.173(c).

3. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. Although the applicants state that "the error in claiming less than we had a right to claim arose without deceptive intent on our part" in the reissue

Art Unit: 1734

declaration, applicant's do not state that all errors arose without any deceptive intent.

See 37 CFR 1.175 and MPEP § 1414.

Claims 1-25 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Allowable Subject Matter

5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, in a method for welding first and second parts together, the prior art does not teach or make obvious the concept of moving the holder toward the spindle to bring the second part into frictional contact with the first part, then decreasing the speed of rotation of the spindle and mounted first art and simultaneously moving the holder towards the spindle, and stopping rotation of the spindle and mounted first part at a specific angular orientation of the first part relating to the second part in the manner claimed by the applicant.

Art Unit: 1734

Regarding claim 9, in a method for welding first and second parts together, the prior art does not teach or make obvious the concept of calculating a set of weld parameters used to control the friction welding machine, the set of welding parameters including a desired spindle speed and a desired spindle position, comparing the measurement with at least one of the desired spindle speed and desired spindle position and adjusting at least one of the actual spindle speed or the actual spindle position so that the actual spindle position is substantially similar to the desired spindle position in the manner claimed by the applicant.

Regarding claim 22, in an apparatus for controlling a friction welding machine, the prior art does not teach or make obvious the concept of the computing device being programmed to receive a status signal from the position sensor indicative of an actual spindle position at a specific time point and to compare the actual spindle position to the desired spindle position calculated from the set of input parameters at the specific time point and to cause the motion controller to deliver a difference signal to make any necessary corrections to the rotational speed in the manner claimed by the applicant.

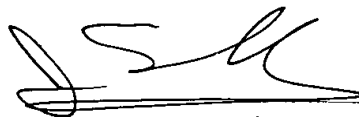
Telephone/Fax

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (703) 308-2090. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

Art Unit: 1734

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. Sells', written over a horizontal line.

**JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700**